Our File: 5043CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Seguin et al.		
Serial No.:	10/056,352	**Group No:**	2876
Filed:	January 24, 2002	**Examiner:**	K. Koyama
For:	TEST TUBE WITH DATA MATRIX CODE MARKINGS		

Box Non-Fee Amendment
Assistant Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT TRANSMITTAL

1. Transmitted herewith is an amendment for this application.

STATUS

2. Applicant is

__ a small entity - verified statement:

__ attached.

__ already filed.

_X_ other than a small entity.

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United State Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner of Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Meghan H. Carr
(Type or print name of person mailing letter)

Date: 09/04/03

Meghan H. Carr
(Signature of person mailing paper)

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments)--If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 CFR 1.645 for extensions of time in interference proceedings and 37 CFR 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply

(complete (a) or (b) as applicable)

(a) __ Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

Extension (months)		Fee for other than small entity	Fee for small entity
__	one month	$ 110.00	$ 55.00
__	two months	$ 400.00	$200.00
__	three months	$ 920.00	$460.00
__	four months	$1,440.00	$720.00
__	fifth month	$1,960.00	$980.00

Fee $

If an additional extension of time is required please consider this a petition therefor.
(check and complete the next item, if applicable)

__ An extension for _____ months has already been secured and the fee paid therefor of $_____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request $

OR

(b) X Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 CFR 1.16(b)-(d)) has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	SMALL ENTITY			OTHER THAN A SMALL ENTITY
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOREXTRA	PRESENT RATE	ADDIT. FEE	OR	RATE	ADDIT. FEE
TOTAL.		MINUS		=	x 9= $		x18=	$
INDEP.		MINUS		=	x 42= $		x84=	$
	FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				+140=$		+$280=	$
					TOTAL ADDIT. FEE $		OR FEE	TOTAL ADDIT. $

If the entry in Col. 1 is less than entry in Col. 2, write "0" in Col. 3.
If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".
If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: "After final rejection or action (. 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made." 37 CFR . 1.116(a) (emphasis added).

(complete (c) or (d) as applicable)

(c) X No additional fee for claims is required.

OR

(d) __ Total additional fee for claims required $_____.

FEE PAYMENT

5. __ Attached is a check in the sum of $_____.

__ Charge Account No. _____ the sum of $_____.

A duplicate of this transmittal is attached.

FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).

6. X If any additional extension and/or fee is required, charge Account No. 19-0079

AND/OR

X If any additional fee for claims is required, charge Account No. 19-0079

SIGNATURE OF ATTORNEY

Reg. No.: 20,798

Maurice E. Gauthier
Type or print name of attorney

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SERIAL NO:	10/056,352	**EXAMINER**:	K. Koyama
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Sir:

RESPONSE

The Office Action dated June 24th, 2003 has been received and the comments of the Examiner have been carefully considered. Claims 22-36 have been rejected by the Examiner. Claims 22-36 remain pending.

Claims 22-32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wijnschenk et al (U.S. Patent 6,270,728) in view of Moh et al. (U.S. Patent 6,165,594), claims 33-36 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wijnschenk et al. in view of Moh et al. and Mizobuchi et al and Claims 22-36 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,372,293 (hereinafter the '293 patent).

A. Introduction

On May 29, 2003, Applicants filed an Appeal Brief, (hereinafter "the Appeal Brief"), in response to the Examiner's final rejection of claims 22-36. On June 24, 2003, the Examiner issued an Office Action (hereinafter "the present Office Action") in response to the Appeal Brief and reopened prosecution of the above-identified application. Excluding an obviousness type double patenting rejection of claims 22-36, the bases for the rejections of claims 22-36 set forth in present Office Action are identical to the bases for the rejections of claims 22-36 from which Applicants previously appealed.

1. Piecemeal Prosecution

It is clear from section 707.07(g) of the Manual of Patent Examining Procedure (hereinafter 'the MPEP") that the Examiner should reject each claim on all valid grounds available to avoid piecemeal prosecution of the application. In order to conduct a proper examination of a patent application, it is axiomatic that the effective filing date of the application be determined. See section 706.02 entitled "Determini ng the Effective Filing Date of the Application". Moreover, the Examiner, if aware of two co-pending applications filed by the same inventive entity, must determine whether an issued of double patenting could exist if one of the co-pending application issued as a patent. See section 804 B. entitled "Between Copending Applications-Provisional Rejections".

The Examiner reopened prosecution of the application subsequent to Applicant's filing of the Appeal Brief to include an obviousness type double patenting rejection of claims 22-36 in view of the '293 patent. The '293 patent matured from U.S. Pat. Appln. Ser. No. 09/399,405 (hereinafter "the '405 application"). The instant application is a continuation of the '405 application.

It is inconceivable to Applicants how the Examiner would have been unaware of the '405 application at the time the instant application was filed because a proper examination of the instant application required the determination of its effective filing. The Examiner's failure to timely raise such a rejection has caused the Applicants to incur unnecessary costs with respect to the prosecution of the application. Should it become necessary to file a second Notice of Appeal, Applicants fully intend to place this matter squarely before the Director by petitioning for at least a refund of monies paid to the Patent Office for filing the first Notice of Appeal and the Appeal Brief.

B. Discussion

1. Double-Patenting Rejection

Enclosed herewith is a terminal disclaimer to obviate the obvious type double patenting rejection together with a check in the amount of $110.00.

2. Obviousness Rejections

The issues are whether the Examiner was correct in rejecting independent claims 22 and 29 under 35 U.S.C. 103(a) as being unpatentable over Wijnschenck et al. in view of Moh et al., the remaining dependent claims being rejected on the same or primarily the same premise as that of claims 22 and 29.

Claim 22 claims a test tube having a unitary construction, with machine readable data encoded within an opaque coating deposited onto the exterior surface of the tube bottom.

Claim 22 stands rejected as being obvious over Wijnschenk et al. in view of Moh et al. Wijnschenk et al. teaches machine readable data encoded on a separate carrier part 6 attached to a test tube bottom. Moh et al. teaches a temperature resistant label that is attachable to a

substrate. Neither Wijnschenk et al. or Moh et al., either when viewed singly, or in combination, disclose or suggest the unitary test tube concept claimed in claim 22, where the machine readable data is encoded within an opaque coating on the exterior bottom surface of the test tube. It follows, therefore, that the rejection should be withdrawn, and this case passed to issue.

There is ample precedent for doing so. The '405 application is a continuation of the '293 patent, a copy of which is attached as Exhibit A to the Appeal Brief. Claim 1 of the '293 patent reads as follows:

> A test tube, comprising:
>
> a tube body of unitary construction comprising an enclosed sidewall and an integral bottom that together define a tubular container having an open top, wherein said bottom has a concave interior surface and a planar exterior surface upon which machine readable data is encoded within multi-layered opaque coatings of contrasting colors that are deposited onto said planar exterior surface to uniquely identify said test tube. [emphasis added]

During prosecution of the '405 application, this claim was rejected under 35 U.S.C. §103 as being unpatentable over WO/9805427 (hereinafter "the '427 application") in view of Moh et al. See Exhibit C attached to the Appeal Brief. The '427 application is the same as Wijnschenk et al. In response to the rejection of claim 1, Appellants submitted arguments to overcome the obviousness rejection of claim 1. See Exhibit D attached to the Appeal Brief. The Examiner ultimately allowed claim 1 after recognizing that the primary issue in regard to the patentability of claim 1 was whether the '427 application in view of Moh et al. taught or suggested a test tube of unitary construction. See Exhibits E and C attached to the Appeal Brief. Although claim 22 is broader than claim 1, the same "unitary construction" issue is present here, and pursuant to the doctrine of *res judicata* the Examiner should be precluded from departing from the Patent

Office's previous decision.[1]

Contrary to the Examiner's statements on pp. 5-8 of the present Office Action the shape of the exterior surface of the tube body and/or whether the coating is single or multi-layered is simply not relevant to the Patent Office's previous determination that the combined references do not teach or suggest a combination which includes at least the limitation of a tube body having a unitary construction. It is, of course, required that combined references, either when viewed singly or in combination, teach or suggest each limitation of the presently claimed invention to support a *prima facie* case of obviousness. Thus, it is submitted that the Examiner can not, pursuant to the doctrine of *res judicata*, rely on the combined cited references as teaching or suggesting at least the limitation of claim 22 relating to the unitary construction of the tube body and hence the obviousness rejection should be withdrawn.

Claim 29 is directed to a method which comprises the steps of providing a tube body of unitary construction having a bottom exterior surface, applying an opaque coating to the exterior surface and encoding machine readable date within the opaque coating. For the reasons discussed above, it is respectfully submitted that Wijnschenk et al., either alone or in combination with Moh et al., fails to teach or suggest a method of manufacturing a test tube comprising at least the steps of providing a test tube having a tube body of unitary construction.

[1] The doctrine of *res judicata* is not only applied to judicial court proceedings but is also applied to quasi-judicial action in the Patent Office. Overland Motor Company v. Packard Motor Company et al., 274 U.S. 417 (1927). The issuance of '293 patent, a quasi-judicial action by the Patent Office, waives the right of the Patent

C. Conclusion

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance and an early indication of the same is earnestly solicited.

Respectfully submitted,

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Office to raise identical issues in a continuation application, which claims priority from the issued patent, that were finally decided during the prosecution of the issued patent. Id. at 421.